

REMARKS

The Present Invention

This reissue application is related to low volatility formulations of microencapsulated clomazone and processes for the preparation thereof. The unique formulations provide reduced volatility when compared with an emulsifiable concentrate formulation of clomazone.

The Pending Claims

Claims 1-37 and 39-49 are pending in this reissue application. As background, the '780 patent contained fourteen claims as issued. Applicants amended claims 1-14, as issued, and added new claims 15-47 when this reissue application was filed. A Preliminary Amendment was filed on May 27, 1999 wherein Applicants requested cancellation of claims 22-47 and addition of new claims 48-64. However, after several conversations with the Examiner it was determined that the Preliminary Amendment was never matched to the file and, accordingly, the amendments requested therein were never made in the record. In an Amendment & Response to Office Action filed on February 22, 2001, Applicants requested that the Preliminary Amendment *not* be entered into the record in order to expedite prosecution, and instead, Applicants requested the entry of claims 48 and 49. In an Amendment & Response to Office Action filed on August 8, 2002, Applicants requested that claim 38 be cancelled and that claims 2, 4, 6, 28, 37, 39, and 40 be amended. Claims 1-37 and 39-49 relate to novel and unobvious low volatility formulations of microencapsulated clomazone and processes for the preparation thereof.

Reissue Declaration

At page 2 of the Office Action, claims 1-37 and 39-49 stand rejected under 35 U.S.C. § 251 for allegedly being based upon a defective declaration. Specifically, the Office Action contends that the reissue oath/declaration filed on February 22, 2001, is defective because it fails to identify at least one specific error which is relied upon to support the reissue application.

Without acceding to the correctness of the Examiner's position, Applicants respectfully submit herewith for consideration an executed supplemental reissue declaration under 37 C.F.R. § 1.175. Said supplemental declaration identifies at least one error which is relied upon as support for the reissue application. Acknowledgement that the supplemental reissue declaration is acceptable is respectfully requested.

Rejections under 35 U.S.C. §112, first and second paragraphs

At page 3 of the Office Action, claims 1, 8, 15, 16, 19, 22-42, 48 and 49 are rejected under 35 U.S.C. §112, first paragraph, as allegedly being non-enabling. The Examiner's position is essentially that the above claims are not enabled since such do not recite the presence of an antifoam agent. The Examiner does not cite any reference material to demonstrate that undue experimentation would be required to make and use the present invention without an antifoam agent. Instead, the Examiner relies solely on Applicants' specification.

Applicants respectively traverse this rejection and request full reconsideration thereof based on reasons of record, which are incorporated herein, as well as the following comments.

More specifically, Applicants respectfully submit that one skilled in the art would be able to make and use the presently claimed invention (with or without an antifoam agent) without

undue experimentation. Simply put, the specification, including the claims, does not state that the antifoam agent is “critical” or “essential” or “required” in order to make and use the present invention having the volatility reduction as compared to an emulsifiable concentrate. The proper reading of claim 1 indicates that the antifoam agent is an *optional* component, and there is nothing in the specification that is inconsistent with this interpretation. Claim 1 granted as originally filed and states, in part:

...a) providing an aqueous phase containing 0.3 to 3.0 wt. % of one or more emulsifiers; optionally 0.02 to 0.20 wt. % of a xanthan gum viscosity modifier/stabilizer, and 0.1 to 1.0 wt. % of an antifoam agent; ...

The semicolon and comma in the above are important to properly interpreting the meaning of the claim on this issue. It is respectfully submitted that the proper way to interpret claim 1 and the use of the semicolon and the comma above is that the semicolon communicates the break between the *required* components and the *optional* components in the aqueous phase. If this were not true, why then was the semicolon used? If the antifoam agent is “critical” or “essential” or “required,” why does it not precede the semicolon rather than follow it? In addition, nothing in the specification or file wrapper states that such is “critical” or “essential” or “required” in order to make and use the present invention. It is respectfully submitted that the plain meaning of claim 1 is that the antifoam agent is an *optional* component.

The Examiner appears to consider this argument (e.g., see page 4 of the Office Action), but discounts such because of the Examiner’s contention that the above reading is in “clear contradiction to the rest of the specification” and that it “would be inappropriate to rely solely on punctuation” under such circumstances.

Applicants are not ignoring the teachings in the remainder of the specification. Rather, Applicants do not agree with the Examiner's view that the above plain meaning of claim 1 is clearly inconsistent with the specification or the Examiner's inference that the above plain meaning is obviously not what was intended by Applicants when this case was filed. Applicants acknowledge that the examples in the specification contain an antifoam agent and that there are numerous embodiments of the present invention describing the use of an antifoam agent in the formulation and process (e.g., col. 1, lines 56-60 and col. 2, lines 16-21). However, nowhere in the specification does it state that the antifoam agent is "critical" or "essential" or "required" to making or using the present invention or any language whatsoever stating that the formulation of this invention *would not work if the antifoam agent is not present*. These words are not used. Merely listing a component as being present does not mean the component is "critical" or "essential" or "required" to making and using the present invention and it is not correct to infer that this is necessarily the case.

Furthermore, this rejection is based on an alleged lack of enablement; i.e., that one skilled in the art would not be able to make and use the present invention containing no antifoam agent without undue experimentation. It is respectfully requested that the Examiner consider what it is that the antifoam agent is doing in the present invention. Antifoam agents are generally inert (such as the antifoam agent disclosed in the specification). The antifoam agents are generally added to the formulation in order to prevent foaming in the tank when the formulation is mixed with water by the farmer. Its absence would not require undue experimentation to prepare and use a formulation having the desired volatility. Applicants advise that the present invention

could readily be made and used without an antifoam agent and all that is required here is to simply leave it out. The present specification is not inconsistent with this point.

In view of the foregoing, it is respectfully submitted that the present claims are fully enabled by the specification and the knowledge and skill in the art and that the Examiner has failed to show why one skilled in the art would not be able to make and use the present invention containing no antifoam agent without undue experimentation. Accordingly, withdrawal of this rejection is respectfully requested.

At page 6 of the Office Action, claims 1, 8, 15, 16, 19, 22-42, 48 and 49 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting "essential" elements. Similar to the rejections set forth above, the Office Action contends on page 6 that the antifoam agent is an omitted "essential" element.

Applicants respectfully traverse the rejection and request reconsideration for the reasons set forth above, as well as those of record. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

In view of the remarks presented above, Applicants respectfully submit that the pending claims are in condition for allowance. Early, favorable action is earnestly requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§ 1.16 and 1.17 that may be required in filing this paper to Deposit Account No. 06-1440.

If, in the opinion of the Examiner, a telephone conference with the undersigned would facilitate prosecution of this patent application, the Examiner's call would be welcomed.

Respectfully submitted,



Date: May 22, 2003

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